

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD JOHN ROSENBERGER

Appeal No. 2007-1449
Application No. 09/634,612
Technology Center 3600

Decided: August 29, 2007

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 146-205.¹
35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6 (b) (2002).

The invention is directed to providing a health reminder associated with transaction statements, wherein the health reminder is not related to a product purchase listed on the transaction statement. As an example, the Specification (p. 5) describes including the health reminder on a credit card statement.

¹ Claims 1-145 have been canceled.

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Claims 146-205 are rejected under 35 U.S.C. §103(a) as being unpatentable over Byerly (US Patent 6,067,524) in view of Bucci (US Patent 5,655, 089) and Masuda (US Patent 5,569,897).

We AFFIRM.

Appellant, in the Appeal Brief², argues the claims together.

Because Appellant argues claims 146-205 as a group, pursuant to the rules, the Board selects representative claim 146 to decide the appeal with respect to this rejection, and claims 147-205 will stand or fall with claim 146. 37 C.F.R.

§ 41.37(c)(1)(vii) (2006). Claim 146 reads as follows:

146. A method of providing health reminders with transaction statements sent to or accessed by end users of financial cards and related financial card customer services, wherein the health reminder is not related to a product purchase listed on the transaction statement, said method comprising the steps of:

a. providing said health reminder associated with transaction statements to said end users, wherein the health reminder is not related to a product purchase listed on the transaction statement and said financial cards and said related financial card services enables said end users to perform financial card functions relating to and comprising the purchase goods and services, and;

b. wherein said method optionally further provides at least one of:

i. said health reminder acts as a health awareness tool for said end users;

² Our decision will make reference to the Revised Appellant's Brief on Appeal ("Appeal Br.," filed Mar. 6, 2006), the Examiner's Answer ("Answer," mailed May 18, 2006), and to the Reply Brief ("Reply Br.," filed Jul. 21, 2006).

ii. said health reminder comprises at least one health related reminder(s), tip(s), or suggestion(s) for said end users and/or individuals related to or otherwise associated with said end users with regards to any health-related topic(s), health-related preventive measure(s), medical check-up(s), medical examination(s), or medical procedure(s);

iii. said health awareness tool encourages said end users to take self-initiative or self-action to heed said health-related preventive measure(s), to schedule said medical check-up(s), said medical examination(s), or said medical procedure(s);

iv. said health awareness tool is not used to remind said end users of a preexisting or already scheduled doctor appointment, but rather to raise health awareness and to encourage said end users to self-schedule said medical check-up(s), said medical examination(s), and/or said medical procedure(s) in absence of any direct prompting from the doctors or health care professionals of said end users;

said method optionally further comprising at least one of:

(c) attracting potential end users to said financial cards and said related financial card customer services comprising said health reminder;

(d) converting said potential end users into said end users by enabling said potential end users to apply for said financial cards and said related financial card customer services, where the application for said financial cards and said related financial card customer services reflects the preferences, desires, or consent of said end users to receive said health reminder, or, in the case of said health reminder being offered to existing end users of financial cards and related financial card customer services, where said existing end users express preferences, desires or consent to receive said health reminder, and comprising the step of providing said potential end users with the step of applying for said financial cards and said related financial card customer services, where said the step of applying for said financial cards and said related financial card customer services comprises the use of any communicative format;

(e) approving said potential end users to become approved said end users of said financial cards and said related financial card customer

services, where the receiving of said health reminder is contingent upon said potential end users becoming said approved said end users of said financial cards and said financial card customer services, and where said health reminder is offered as an incentive for said potential end users to become said end users for said financial cards and said related financial card customer services;

(f) providing and relaying prompts to said end users relating to said health reminder, where said the step of providing and relaying prompts comprises the use of any communicative format, and where said step of providing and relaying prompts to said end users may occur at any time before, during, or after said potential end users have become said approved end users of said financial cards and said related financial card customer services;

(g) receiving end user data relating to said health reminder, where said step of receiving said end user data comprises the use of any communicative format, and where said step of receiving said end user data relating to said health reminder may occur at any time before, during, or after said potential end users have become said approved end users of said financial cards and said related financial card customer services;

(h) storing said end user data on a computer readable medium relating to said health reminder;

(i) allowing said end users to perform transactions relating to said financial cards and related financial card customer services, using said financial cards, resulting in transaction data;

(j) storing said transaction data on a computer readable medium;

(k) providing said health reminder to said end users based on said prompts and said end user data, where said step of providing said health reminder comprises the use of any communicative format; and,

(l) providing financial card transaction statements to said end users based on said transaction data, where said step of providing said financial card transaction statements comprises the use of any communicative format.

A. Issue

The issue is whether Appellant has shown that the Examiner erred in holding the combination Byerly, Bucci, and Masuda would have rendered the subject matter of claim 146 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Claim construction

1. A large part of the subject matter defined by claim 146 is optional. That part of the claimed method that is not optional reads:

146. A method of providing health reminders with transaction statements sent to or accessed by end users of financial cards and related financial card customer services, wherein the health reminder is not related to a product purchase listed on the transaction statement, said method comprising the steps of:

a. providing said health reminder associated with transaction statements to said end users, wherein the health reminder is not related to a product purchase listed on the transaction statement and said financial cards and said related financial card services enables said end users to perform financial card functions relating to and comprising the purchase goods and services

2. Step a. of claim 146 has two parts. The first part provides for a health reminder associated with a transaction statement to a user. The first part further characterizes the health reminder as being “not related to a product purchase listed on the transaction statement.” The second part relates to the transaction statement.

In accordance with the preamble of the claim, the transaction statement is one that is sent to or accessed by end users of, for instance, financial cards. The second part further characterizes such financial cards as enabling the end users to perform financial card functions relating to and comprising the purchase goods and services.

3. The Specification gives no term in the claim a special meaning.
4. The Specification (p. 5) mentions credit cards as an example of “financial cards.”
5. The Specification (p. 5) states that “the scope of the invention includes other periodic reminders, tips, or suggestions on printed or online credit card statements, health related or not, that pertain to matters other than credit cards and related services.”
6. The Specification does not define the term “related” as used in the claim phrase “not *related* to a product purchase listed on the transaction statement.”
7. The ordinary and customary meaning of “related” is “connected or associated”. See p. 1132 of Webster’s New World Dictionary for **related**, definition 2.

Scope and content of the prior art

Byerly

8. Byerly is directed to a method of generating advisory information for pharmacy patients. Byerly discloses appending an advisory message to a “data record.” Col. 2, ll. 41-42. The advisory message include

all types of information provided to pharmacy patients, including information about the prescribed product being dispensed, information about related products or procedures, patient-specific information (such scheduling of appointments, physicals etc.), promotional materials and/or discount information pertaining to the purchase of prescription products and/or other products, and/or simply news items pertaining to the dispensed product and/or to pharmaceutical products and/or health in general.

(Col. 2, ll. 54-66.)

9. Appellant argues that (a) Byerly “teaches adding medical advisory information to pharmacy transaction information *that is relevant to the pharmaceutical for which the patient had bought through the use of a doctor’s prescription*. This aspect of Byerly et al. is specifically excluded from the present claims” (Appeal Br. 10, see also Reply Br. 3-4) and (b) Byerly does not require the end user to obtain or use a financial card to service (Appeal Br. 10-11).

10. Byerly discloses health reminders.

Bucci

11. Bucci discloses credit card statements are known. (Col. 1, ll. 12-35.)

12. Appellant argues that “Bucci does not teach providing the end user with financial cards, such as credit and/or debit cards, nor does Bucci teach providing the end user with related financial card customer services” (Appeal Br. 11.)

(See also Reply Br. 5.)

13. Bucci discloses credit card statements.

Masuda

14. Masuda is directed to “a system for issuing credit cards to customers for use in selling goods and services” (Col. 1, ll. 8-10.)

15. Appellant argues that “unlike the present invention, [Masuda] totally fails to teach the claimed “related financial card customer services.” (Appeal Br. 11.) (See also Reply Br. 6.)

16. Masuda discloses a credit card system.

17. Financial customer services related to credit cards (e.g., a help desk) are well known.

Differences Between the Prior Art and the Claimed Invention

18. The Examiner found that although Byerly and Bucci disclose “how health care reminders may be presented to an end user who conducts a transaction, it is not explicitly disclosed on how the end user’s credit card being used in the transaction is issued or used” (Final Rejection, p. 4.) The Examiner relies on Masuda to show that issuing and using a credit card is known. Accordingly, the Examiner takes the position that each limitation of the claim is disclosed in one of the cited references.

19. The difference between the prior art and the claimed invention is that the claim combines subject matter which is separately disclosed in the references.

The level of ordinary skill in the pertinent art.

20. Neither the Examiner nor Appellant has addressed the level of ordinary skill in the pertinent art of using optimization models to customize commercial operations. We will consider Byerly, Bucci, and Masuda as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001) (“[T]he absence of specific findings on

the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown.’”).

Objective evidence of nonobviousness

21. Appellant presented no evidence of secondary considerations of non-obviousness for our consideration.

Reasoning in support the legal conclusion of obviousness

22. Appellant argues that there is no motivation to combine what Appellant alleges are “unrelated teachings of” the cited references. (Appeal Br. 12 and Reply Br. 12.)

23. Appellant further argues that the references teach away from the claimed invention and for that reason, according to Appellant, the Examiner used hindsight to reach the claimed invention from the combined teachings of the references.

Appeal Br. 13-14 and Reply Br. 7-9. According to Appellant, Byerly and Bucci teach away because they teach different (1) methods of delivery of materials to the end user (Appeal Br. 15-16 and Reply Br. 9-10), (2) cycles of time for delivering information (Appeal Br. 16-17 and Reply Br. 10-11), and (3) times when payment is made in relation to the consumption of a product or service (Appeal Br. 17-18 and Reply Br. 11-12). Specifically, Appellant argues that (1) Bucci teaches electronic delivery and Byerly teaches actual pickup of advisory messages, (2) Bucci teaches delivering information on a periodic basis while Byerly teaches delivery on an incidental basis, and (3) Bucci teaches settling an account after consumption of a good or service and Byerly teaches settling account prior to consumption.

24. In reaching a conclusion of obviousness, the Examiner made the following statements:

- “[I]t would have been obvious to send the health care reminders being presented to the end user in Byerly through the postal mails along with the billing statement. One would have been motivated to send this information through the mail in order to present Byerly’s reminders to end users whose prescriptions are being filled remotely, e.g., telephonic, mail order, or on-line.” (Final Rejection, p. 3-4.)
- “[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to use a credit card which had been advertised, issued, and approved in a manner similar to Masuda when conducting the pharmacy transaction in Byerly. One would have been motivated to use such a credit card in order to preclude the end user from having to carry a large amount of cash, which has been recognized as one of the major advantages of credit cards versus cash payments.” (Final Rejection, pp. 4-5.)
- “It would have been obvious that once a system had been set up which places personalized messages on a billing statement, the messages may be directed towards any topic chosen by the message provider.” (Final Rejection, p. 5.)

C. Principles of Law

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known

methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.”

Id., citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

D. Analysis

The patentability of claim 1 under 35 U.S.C. § 103(a) (2002) depends on whether the claimed subject matter is obvious over Byerly, Bucci, and Masuda.

The claimed method involves the use of a health reminder, a transaction statement, financial cards, and related financial card services. Each of these products are well known and within the common knowledge of those in the arts of finance and information dissemination. FF 10, 13, 16, and 17. Each product claimed performs as one of ordinary skill in the art would expect it to perform and performs a known function in the art of investing and information dissemination. The claimed method covers sending health reminders and transactions statements to end users of credit cards and credit card-related financial services. The claimed method requires these products to do no more than what one would expect them to do were they to be combined; that is, providing a credit card and credit card-related financial services user with information about health and credit card transactions. Accordingly, the Examiner has made out a prima facie case of obviousness. “The

combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). In that regard, the record does not include objective evidence of nonobviousness (FF 21). Thus Appellant has not rebutted the prima facie case with evidence of unexpected results.

On whether the references as a whole suggest the claimed feature of providing a health reminder that “is not related to a product purchase listed on the transaction statement,” we find that one of ordinary skill in the art with the prior art in hand would foresee providing health reminders that are related or not related to products on the transaction statement. Bucci teaches credit card statements in general and Byerly teaches health reminders which, for example, could be a newsletter. Given that credit card statements will list any number of purchases, and in most cases list items unrelated to health, the inclusion of Byerly’s newsletter would, predictably, yield the claimed combination of a health reminder that “is not related to a product purchase listed on the transaction statement.” Again, in the absence of objective evidence of nonobviousness, we conclude as the Examiner has, that this subject matter would have been obvious to one of ordinary skill in the art over the cited prior art.

Appellant has challenged relevance of each cited reference to the claimed invention. FF 9, 12, and 15. However, the test for obviousness is what the *combined* teachings of the references would suggest to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed.

Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Whether or not an individual reference teaches a specific step of the claimed method is not dispositive of the question of obviousness. Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Appellant also challenges the prima facie case of obviousness on the ground that there is no motivation to combine the cited references. FF 19. However, while “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), the Examiner here *did* provide reasons to support the legal conclusion of obviousness. FF 24.

Appellant does not so much challenge the logic underlying the Examiner’s reasoning as argue, as a matter of law, that where, as is alleged to be the case here, (a) the references are unrelated to each other (FF 22) and (b) the references do not contain a teaching or suggestion to combine them, a case of obviousness cannot be made out. This is incorrect because (a)

[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one

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device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)
and (b)

“[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.”

Id. at 1739, 82 USPQ2d at 1396.

Finally, extending on Appellant’s view that the references are unrelated to each other, Appellant challenges the prima facie case of obviousness on the grounds that the references “teach away” from each other. FF 23. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ 1130 (Fed. Cir. 1994).

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However, we see nothing in the references that teach away from combining health reminders and credit card statements. Appellant focuses on distinctions between Bucci and Byerly in how they deliver information, when they deliver it, and when accounts are settled. But in our view these alleged distinctions suggest to those of ordinary skill in the art alternative ways of delivering information and settling accounts, not teachings discouraging one of ordinary skill in the art to combine health reminders and credit card statements.

Having addressed all Appellant's arguments and found them unpersuasive as to error in the rejection, we affirm.

E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting the claims over the prior art.

DECISION

The Examiner's rejection of claims 146-205 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

vsh

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